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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,627	12/30/2003	Todd D. Danielson	5465A	7488

7590 09/22/2004

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EXAMINER
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METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/748,627

Applicant(s)

DANIELSON ET AL.

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-3 are pending.

#### ***Specification***

1. The abstract of the disclosure is objected to because: the abstract does not comply with 37 CFR 1.72(b), i.e., "The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length."

Correction is required. See MPEP § 608.01(b).

2. Applicants should update the status of the parent application in the cross-noting section of the specification as it changes.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of

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35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushita et al, US 5,922,246 in view of Greshes, US 6,074,579.

Matsushita et al (column, lines 36-51) disclose making a lens from a synthetic resin comprising an organic dye with an absorption maximum in the vicinity of the central wavelength on the standard relative visibility curve, as well as a UV light absorbing agent and a blue light absorbing agent, the base material having a transmittance minimum in the range wavelengths extending from 550 to 585 nm on the transmittance curve, noting that the synthetic resin base material in the lens may further comprise an IR light absorbing or reflecting agent. In Example 5 Matsushita et al use a polycarbonate resin, a UV light absorber, a blue light absorber and an IR light absorber, the minimum transmittance (or maximum absorption) wavelength (Fig. 5) being within the range recited in applicants' claims. While Matsushita et don't disclose the use of a polyester resin in their lens formulation, it would have been obvious to one skilled in the art at the time applicants' invention was made to use a polyester resin in lieu of the polycarbonate in Example 5 of Matsushita et al., since they contemplate using "a synthetic resin" broadly, and since Greshes (column 4, lines 40-51) disclose the interchangeability of polycarbonates and thermoplastic polyesters, inter alia. Further, as to composition claim 3 herein, a "liquid dispersion" reads on the molten mixture of the combination of references, noting Matsushita et al. (column 3, lines 61-67).

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6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over General Electric Company, WO 01/19921 (hereafter GE '921). GE '921 (page 7, line 1; page 8, line 1; examples and claims) disclose polyester films employing dyes including Macrolex Violet B (absorption peak maximum between 576 and 605 nm) or Macrolex violet 3R (absorption peak maximum between 555 and 575 nm).

It is further noted that these are the preferred components of the instant application, exemplified and commonly known as solvent dye 13 and solvent dye 36, respectively.

GE '921 differs from the claims in the use of a combination of colorants as instantly claimed rather than a single colorant exemplified in the GE '921 reference.

GE '921 (page 5, lines 20-24) discloses the Macrolex Violet B and Macrolex violet 3R dyes as dyes known in the art and clearly contemplates the disclosed dyes to be used either singly or in combination. GE '921 (page 12, lines 7-13) teaches the further addition of *uv* absorbers, i.e., *uv* screeners.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the combination of dyes having adjacent absorption spectrums for the advantage of the particular color desired by the combination and for a broader range of absorption by the combination of materials absorbing at different wavelengths.

Furthermore, it is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same

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purpose in order to form a third composition useful for that same purpose. *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in *Kerkhoven* and *Crockett*, the idea of combining them flows logically from their having been individually taught in the prior art.

GE '921 (page 4, lines 13-17) discloses the polymers may be prepared in interfacial systems, solutions, in melts or in the solid state. The properties would have been inherent to the use of the individual components for their taught functions. Said combinations would have been *prima facie* obvious for their taught functions.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of

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copending Application No. 10/140,700. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation. Copending 10/140,700 discloses polyester fiber or article comprising at least one compound that provide bluing effects within said fiber or article and optionally at least one ultraviolet absorbing compound; wherein said compound(s) exhibits at least one absorption peak and  $\lambda_{\max}$  between 565 and 590 nm within the polyester fiber or article; and wherein said bluing agent exhibits a half-height bandwidth of at most 115 nm in relation to the at least one absorption peak. Thus, it is clear that there is significant overlap between the copending claim and the present claim. Specifically, both claims are drawn to polyester fiber or article comprising bluing agent and optionally at least one UV absorbing compound wherein the bluing agent exhibits single absorption peak and  $\lambda_{\max}$  between 565 and 590 nm.

The only "differences" between the present claim and the copending claim are:

(a) The copending claim requires "at least one" bluing agent that provide bluing effects while the present claim is a combination of at least two different compounds that provide bluing effects. However, the generic disclosure of bluing agent in the copending claim clearly encompasses any type or number of compounds that provide bluing effects including the at least two different compounds as required in the instant claim. Thus, it is clear that the specific bluing agent disclosed in the copending claim clearly encompasses the generic disclosure of bluing agent as required in the present claim, and thus, one of

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ordinary skill in the art would have arrived at the present invention from the copending one. Furthermore, it is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. *In re Kerkhoven, supra; In re Pinten, supra; In re Susi, supra; In re Crockett, supra.* As stated in *Kerkhoven* and *Crockett*, the idea of combining them flows logically from their having been individually taught in the prior art.

(b) The present claims are directed to generic polyester fiber or article while the copending claim recites clear polyester fiber or article that is colorless within the visible spectrum. However, the generic disclosure of polyester fiber or article in the instant claim clearly encompasses all types of polyester fiber or article including clear polyester fiber or article that is colorless within the visible spectrum. Further, applicants' attention is drawn to MPEP 804 where it is disclosed that ("the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification, which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (Underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to page 6, lines 5-6 and page 7, line 3 of the instant specification (10/748,627), which discloses that using the combination of



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compounds, *i.e.*, bluing agent, set forth in copending claim 1 produces a clear polyester fiber or article that is colorless in the visible spectrum. Thus, although there is no explicit disclosure in the instant claim that the polyester fiber or article is clear and colorless within the visible spectrum, it would have been obvious to one of ordinary skill in the art to the polyester fiber or article is intrinsically clear and colorless within the visible spectrum due to the use of the at least two different compounds that provide bluing effects made thus, one of ordinary skill in the art would have arrived at the present invention from the copending one.

(c) The present claim requires bluing agent with half-height bandwidth of at most 135 nm while the copending claim requires bluing agent with half-height bandwidth of at most 115 nm. Applicants attention is drawn to MPEP 2144.05 which discloses that in "the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art", a *prima facie* case of obviousness exists" *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), *In re Woodruff*, 919 F.2d 1575, 16 USPQ 1934 (Fed. Cir. 1990). Given that the half-height bandwidth in the copending claim clearly overlaps the presently claimed half-height bandwidth and in light of the cited portion of the MPEP, it therefore would have been obvious to one of ordinary skill in the art to arrive at the present invention from the copending one.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

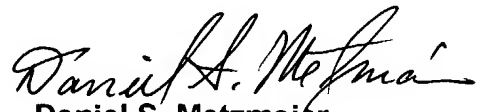
**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712

DSM